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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,834	02/08/2002	Wai Choi Tang	016660-115	9561

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/067,834

Applicant(s)

TANG, WAI CHOI

Examiner

Joshua D. Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/8/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application and IDS filed 2/8/2002.
2. Claims 1-15 are pending in this case. Claims 1 and 13 are independent claims.

Drawings

3. The drawings were received on 2/8/2002. These drawings are accepted.

Information Disclosure Statement

4. The information disclosure statement filed 2/8/2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically a full copy of every foreign patent document must be submitted. It has been placed in the application file, but only the US Patent reference specified has been considered at this point.

Proper correction is required.

Priority

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the Hong Kong Special Administrative Region of the People's Republic of China on February 9, 2001. It is noted, however, that applicant has not filed a certified copy of the 01100950.7 application as required by 35 U.S.C. 119(b):

Specification

6. The abstract of the disclosure is objected to because line 13 of the abstract appears to be a clerical error containing the phrase "[Fig. 1]." It is recommended that line 13 be removed from the abstract. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is non-statutory for at least the reason that it is not tangibly embodied in a manner so as to be executable (i.e. stored on a computer readable storage medium, not including a carrier signal or transmission medium).

Proper correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Chasen et al. (hereinafter Chasen, US Patent Number 6,760,721, filed on April 14, 2000).

Regarding independent claim 1, Chasen discloses providing within a display window in an interface a visual display of a plurality of words arranged hierarchically into a plurality of levels based on a database of those words (column 1, lines 39-50 and column 5, line 52-column 6, line 4 of Chasen). Chasen also discloses that a user may choose a word or words from a plurality of words shown in said window and then outputting an output in response to the choice of a word or words (column 5, line 52-column 6, line 4 of Chasen).

Regarding dependent claims 2 and 3, Chasen discloses that the user's computing device can be a personal computer or a personal digital assistant (column 6, lines 52-62 of Chasen).

Regarding dependent claim 4, Chasen discloses that the database of words provided exists and is provided from the memory of the user's processing apparatus (column 6, lines 22-29 and lines 49-52 of Chasen).

Regarding dependent claims 5 and 6, Chasen discloses that the output in response to the selection may be visual (showing items that fall under the classification of the word selected) and audible (playing the audio filed designated by the word selected) (column 5, line 52-column 6, line 4 and column 8, lines 7-13 of Chasen).

Regarding dependent claims 7 and 8, Chasen discloses that words that are chosen are then displayed in a second window on the visual display unit and in the second window the words chosen are displayed with at least a word of the immediately preceding level (when classical is selected the word classical is shown in the second window in conjunction with the word that immediately precedes it, genre, as is shown in Figure 1) (column 5, line 52-column 6, line 4 of Chasen).

Regarding dependent claims 9 and 10, Chasen discloses displaying a plurality of chosen words in the second window in a relational manner by allowing multiple words such as "Concerto" and "Reverie" to be added to a playlist window that exists in the same format as the window 130 in Figure 1, thus maintaining a relational display of the words selected based on the categories of classification provided (column 5, line 20-column 6, line 4 of Chasen).

Regarding dependent claims 11 and 12, Chasen discloses that words may be added to the database and any changes made to a word will be propagated throughout the database to all occurrences of a word in a database, thus allowing all occurrences to be changed (column 3, lines 43-58 of Chasen).

Regarding independent claims 13, Chasen discloses a program which when processed by a data apparatus provides within a display window in an interface a visual

Art Unit: 2178

display of a plurality of words arranged hierarchically into a plurality of levels based on a database of those words (column 1, lines 39-50 and column 5, line 52-column 6, line 4 of Chasen). Chasen also discloses that a user may choose a word or words from a plurality of words shown in said window and then outputting an output in response to the choice of a word or words (column 5, line 52-column 6, line 4 of Chasen).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasen et al. (hereinafter Chasen, US Patent Number 6,760,721, filed on April 14, 2000).

Regarding dependent claims 14 and 15, Chasen discloses the use of executable programmed instructions in order to perform the tasks of the invention of Chase. Chasen does not explicitly disclose the executable programs are stored in a data carrier, more specifically an optically readable data disc. However, it was notoriously well-known to use an optically readable data disc (such as a CD) to provide executable programs to a processing device at the time the invention was made. It would have been obvious to one of ordinary skill in the art, at the time the invention was made to have provided the program taught by Chasen on an optically readable data

Art Unit: 2178

disc because it would have increased the portability of the program because it would have allowed it to be easily transported computer to computer via the data disc.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 5,404,506

US Patent Number 5,555,408

US Patent Number 6,208,339

US Patent Number 6,393,430

US Patent Number 6,446,080

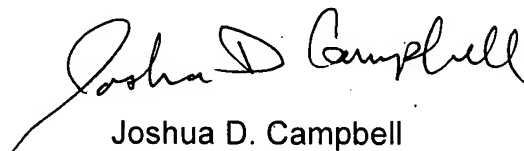
US Patent Number 6,484,149

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joshua D. Campbell